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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/566,425

01/30/2006

Akiyoshi Yamazaki

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3636

20995

7590

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Knobbe Martens Olson & Bear LLP
2040 MAIN STREET
FOURTEENTH FLOOR
IRVINE, CA 92614

EXAMINER

CHU, JOHN S Y

ART UNIT

PAPER NUMBER

1795

NOTIFICATION DATE

DELIVERY MODE

03/23/2009

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

jcartee@kmob.com

eOAPilot@kmob.com

Office Action Summary	Application No. 10/566,425	Applicant(s) YAMAZAKI ET AL.	
	Examiner JOHN S. CHU	Art Unit 1795	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 December 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) 11, 12, 24 and 25 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10 and 13-23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

This Office action is in response to the amendment received December 4, 2008.

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(f) he did not himself invent the subject matter sought to be patented.

2. Claims 1-10 are rejected under 35 U.S.C. 102(f) as being clearly anticipated by SATO et al (2006/0251986).

The claimed invention is drawn to the following:

1. **(Currently amended)** A positive resist composition comprising:
a resin component (A) containing an acid dissociable dissolution inhibiting group whose alkali solubility increases under action of acid; and
an acid generator component (B) that generates acid on exposure, wherein
the resin component (A) is a copolymer comprising a first structural unit (a1) derived from a hydroxystyrene and a second structural unit (a2) derived from a (meth)acrylate ester containing an alcoholic hydroxyl group, in which 10 mol% or more and 25 mol% or less of a combined total of hydroxyl groups within the structural units (a1) and alcoholic hydroxyl groups within the structural units (a2) are protected with the acid dissociable dissolution inhibiting groups,
a weight average molecular weight of the copolymer prior to protection with the acid dissociable dissolution inhibiting groups is ~~2,000~~ 4,000 or more and ~~8,500~~ 8,000 or less,
a molar ratio between the first structural units (a1) and the second structural units (a2) within the resin component (A) prior to protection with the acid dissociable dissolution inhibiting groups is within a range from 80:20 to 70:30,
the second structural unit (a2) is derived from a (meth)acrylate ester containing an adamantyl group with an alcoholic hydroxyl group, and
the acid dissociable dissolution inhibiting group is a 1-lower alkoxyalkyl group.

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SATO et al claims essentially the same invention to a positive photoresist composition wherein the composition comprises resin component, an acid generator component and a solvent. Component (A) comprises a copolymer a first structural unit (a1) derived from hydroxystyrene and a second structural unit (a2) derived from a (meth)acrylate ester having an alcoholic hydroxyl group, and a portion of hydroxyl groups of said structural units (a2) are protected with acid dissociable dissolution inhibiting group wherein the molecular weight of said copolymer resin prior to protection with said dissolution inhibiting group is at least 2,000 but more than 8,500, see claim 1.

SATO et al recites in claim 1 that 10 mol% more and 25 mol % or less of the combined total hydroxyl groups which anticipates the recited 10 mol% or more and 25 mol % or less of a combined total of hydroxyl groups are protected with the dissolution inhibiting groups of current claim 1.

Claim of SATO et al recites the molar ratio of the structural units (a1) and (a2) to be in a range of 95:5 to 75:25 which overlaps and meets the claimed range from 85:15 to 70:30 in claim 1.

SATO et al further meet the claimed structural unit (a2) which is a (meth)acrylate ester containing an adamantyl group with an alcoholic hydroxyl group.

Claim 4 of SATO et al meets the claimed acid dissociable inhibiting group by disclosing a 1-lower alkoxyalkyl group as recited in claim 6.

The claimed inventions are indistinguishable for the essential features and there is no common inventor in the oath/declaration of the applications Therefore it is unclear who the true

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inventors are for the recited positive resist composition as claimed. It is noted that the applications have the same assignee so no interference would be initiated.

3. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Chu whose telephone number is (571) 272-1329. The examiner can normally be reached on Monday - Friday from 9:30 am to 6:00 pm.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Cynthia Kelly, can be reached on (571) 272-1526

The fax phone number for the USPTO is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PMR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/John S. Chu/
Primary Examiner, Art Unit 1795

J.Chu
March 16, 2009